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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/214,875	04/19/1999	HUBERT MANHES	02581P0045A	8095

7590 12/16/2003

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EXAMINER

BUI, VY Q

ART UNIT PAPER NUMBER

3731

DATE MAILED: 12/16/2003

31

Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 31

Application Number: 09/214,875
Filing Date: April 19, 1999
Appellant(s): MANHES, HUBERT

MAILED
DEC 16 2003
GROUP 3700

Wesley W. Whitmyer, Jr.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed September 29, 2003.

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(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

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(7) Grouping of Claims

Appellant's brief includes a statement that claims 24, 30 and 25-29 and 31 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,354,302	KO	11-1994
5,320,627	SORENSEN et al.a	06-1994

(10) Grounds of Rejection

Claims 24-25 and 28-31 are rejected under 35 U.S.C. 102(b) and claims 26-27 are rejected under 35 U.S.C 103(a). This rejection is set forth in prior "Final Rejection", Paper No. 26.

(11) Response to Argument

Basically, the applicant ("Appeal Brief, paper 30") argues that because KO discloses penetration end 18 as blunt, the device of the instant invention is patentable over KO-'302 because even though KO's metal penetration end 18 of the dissectoscope 10 forms a pointed tip as shown in KO's Fig. 2, the metal penetration end 18 can not cut a body wall as recited in claims 24 and 30 of the instant invention. The applicant further argues that the KO-'302 and SORENSEN-'627 devices applied in the "Final Rejection, paper 26" do not disclose explicitly the KO and SORENSEN devices used for cutting a body wall in contrast to the device of the instant invention configured for cutting a body wall and therefore, the device of the instant invention is patentable over KO and SORENSEN.

In response, the examiner contends that:

First, as to independent claims 24 and 30, KO's metal penetration end 18 defines a pointed tip as shown in Fig. 2. Metal penetration end 18, even disclosed by KO as blunt, **can cut a tissue or a body wall** because penetration end 18 defines a pointed tip shown in KO's Fig. 2 and the penetration end 18 is made of a hard material such as metal (col. 9, lines 64-66, KO reference). Further, KO's conical penetration end 18 is rigid enough for pushing **into and through** a various tissue layers (KO reference, col. 8, lines 43-45). Notice that a blunt metal knife still can cut a tissue or a body wall even though more force is required in comparison to the same knife, which is sharpened.

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Notice that "blunt" or "sharp" are relative terms. One person can consider a knife as sharp and another person can consider the same knife as blunt. Since both the device of the instant invention and the KO device have pointed tips which permit a cutting of a body wall, without at least one additional novel structural limitation in the claims of the instant invention, it is not possible to define the device of the instant invention over KO device.

Second, it is recognized that even KO and SORENSEN-'627 devices are not explicitly disclosed to use for cutting a body wall while the device of the instant invention is intended for cutting a body wall. While the differences in the intended uses of the devices may provide some patentable weight for a method claim, however, the intended uses of the devices do not provide much patentable weight for a device claim.

Therefore, device claims 24-31 of the instant application are either anticipated over KO-'032 or unpatentable over the modification of KO device in view of SORENSEN device, because there is no novel structural limitation in the claims to clearly define the instant invention over KO and SORENSEN devices.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,




Vy Q. Bui
December 12, 2003

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